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In re Application of
YI et al.
Application No.: 10/525,241
PCT No.: PCT/US03/26356
Int. Filing Date: 22 August 2003
Priority Date: 23 August 2002
Attorney Docket No.: 7512.145
For: ASSEMBLY OF CHITOSAN ONTO AN
ELECTRODE SURFACE

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: DECISION ON
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This is a decision on applicant's "Request for Reconsideration and Renewed Petition for Revival of an Application for Patent Abandoned Unintentionally", "Request for Correction of Inventive Entity" and "Submission of Declaration under 37 CFR 1.497(d)", filed on 08 January 2007 in the United States Patent and Trademark Office (USPTO), requesting acceptance of the declaration in the above reference application.

BACKGROUND

On 17 March 2006, applicant filed a declaration in response to the 19 August 2005 Notification of Missing Requirements, identifying the international application and listed Li-Qun Wu and Mark J. Kastantin, among those listed in the published international application, as inventors. Applicant did not provide Form PCT/IB/306 adding Li-Qun Wu and Mark J. Kastantin as co-inventors.

On 19 April 2006, a Notification of Defective Response was mailed to applicant indicating that the declaration was unacceptable because (1) it was not executed in accord with 37 CFR 1.66 or 1.68 and (2) inventors Li-Qun Wu and Mark J. Kastantin were not listed on the published application.

On 16 May 2006, applicant filed a response along with a copy of the Request for Recording of A Change to add Li-Qun Wu and Mark J. Kastantin as a co-inventors under PCT Rule 92bis.

On 31 August 2006, a decision was mailed on the submission indicating that the declaration as submitted was not in compliance with 37 CFR 1.497(a) and (b) and that the application was abandoned. A Notification of Abandonment was mailed to applicant on 8 September 2006

On 20 September 2006, applicant filed a petition to revive along with "Request for Correction of Inventive Entity" and "Submission of Declaration under 37 CFR 1.497(d)".

On 14 December 2006, a decision dismissing the petition was mailed indicating that the

written consent of the assignees was unacceptable and the declarations were not in compliance with 37 CFR 1.497(a) and (b).

On 8 January 2007, applicant filed the instant request for reconsideration and renewed petitions.

DISCUSSION

As previously indicated, Li-Qun Wu and Mark J. Kastantin were not named as inventors in the published international application PCT/US03/26356. The declaration submitted on 16 May 2006 identified Li-Qun Wu and Mark J. Kastantin as co-inventors and thus was not in compliance with 37 CFR 1.497(a) and (b). Since Li-Qun Wu and Mark J. Kastantin were not accepted under PCT Rule 92*bis* as co-inventors, it is improper to accept a declaration identifying them as co-inventors. Applicant asks reconsideration of his petition under 37 CFR 1.497(d) to add Li-Qun Wu and Mark J. Kastantin as inventors.

Petition under 37 CFR 1.497(d)

As previously stated, where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s) (See 37 CFR 3.73(b)).¹

Applicant previously satisfied Items (1) and (2) above.

With regard to Item (3), applicant has now provided evidence of the signatory authority of James A. Poulos, III, Executive Director, The University of Maryland Office of Technology Commercialization; and Stephen Anvil, Director, Technology Development The University of Maryland, Baltimore County. Thus, the Written Consent of The University of Maryland Biotechnology Institute, The University of Maryland, College Park and The University of Maryland, Baltimore County (assignees) to correct the inventorship under 37 CFR 1.497(d)(3) consenting to the addition of Li-Qun Wu and Mark J. Kastantin as inventors in this application is acceptable. Item (3) above has now satisfied.

Accordingly, applicant has now met all of the requirements to add Li-Qun Wu and Mark J. Kastantin as co-inventor in the above-identified international application. The petition under 37 CFR 1.497(d) is hereby granted.

Separate newly executed declarations were also submitted and meet the requirements of 37 CFR 1.497 (a) and (b). The proper reply to the petition under 37 CFR 1.137(b), a declaration in compliance with 37 CFR 1.497(a) and (b), has been submitted. The declaration executed by all inventors including Li-Qun Wu and Mark J. Kastantin as a joint inventors in the above referenced application is acceptable and in compliance with 37 CFR 1.497(a) and (b). The petition under 37 CFR 1.137(b) is hereby granted.

¹ The submission establishing ownership by the assignee must be signed by a party who is authorized to act on behalf of the assignee.

CONCLUSION

The petition to revive under 37 CFR 1.137(b) and Request for Correction of Inventive Entity in the above-captioned application are **GRANTED**.

The declarations are executed by all inventors including Li-Qun Wu and Mark J. Kastantin as a joint inventors in the above referenced application, are acceptable and in compliance with 37 CFR 1.497(a) and (b).

The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **8 January 2007**.



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Enclosure: FORM PCT/RO/132